



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,560	05/19/2000	JADWIGA CHROBOCZEK	3339-422	2330

826 7590 05/08/2003

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER
----------

GUZO, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 05/08/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/530,560

Applicant(s)

CHROBOCZEK ET AL.

Examiner

David Guzo

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10 is/are rejected.
- 7) ☒ Claim(s) 1-3, 5-7, 9 and 11-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### Detailed Action

This application contains claim 4 and non-elected sequences drawn to an invention nonelected with traverse in Paper No. 15. **A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.**

Applicants have continued to traverse the Restriction Requirement made FINAL in the previous Office Action. Ordinarily, once a Restriction is made final, any continued arguments by applicants are not considered by the examiner. However, the examiner, in this case, will address applicants' argument that the significant structural element (the transfecting polypeptide sequence) is distinct from the prior art. Applicants, in the traverse of the restriction requirement filed 8/19/02, indicated that the claimed peptide vectors **have a portion of their structure** made up of the motif **X<sub>1</sub>-[F(D/N)PVYPY]-X<sub>2</sub>** and that **this motif** is the significant common structural element which is free of the prior art. However, as previously noted, the prior art (Signas et al., Kajon et al. and Chroboczek et al., previously cited by the examiner) clearly teaches the recited common structural element and the claimed inventions therefore do not relate to a single general inventive concept under PCT Rule 13.1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1636

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Chroboczek et al.

This rejection is maintained for reasons of record in the previous Office Action (Paper #16) and for reasons outlined below.

Applicants traverse this rejection by arguing that the claims as amended differ from the transfecting agent of the Chroboczek et al. reference in that the instant claims recite that the disclosed transfecting peptide alone is capable of transfecting substances into the cytoplasm of eucaryotic cells.

Applicant's arguments filed 2/24/03 have been fully considered but they are not persuasive. It is noted that claim 10 recites a composition for transfecting a chemical substance into cells wherein the composition contains (open language) at least one transfecting peptide comprising (open language) a peptide sequence which is disclosed by Chroboczek et al. (See Example 3). Applicants have not amended this claim to read on a transfection composition which contains, as the only active ingredient, the recited transfection peptide sequence. Therefore, the rejection is maintained.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1636

Claim 8 is vague in that there is no antecedent basis for the term "transfection vector" in claims 1 or 2. This rejection is necessitated by applicants' amendment of claims 2 to delete the term "vector" terminology and substitute the term "composition". Redrafting claim 8 to delete "transfection vector" and substitute "transfecting peptide" would be remedial.

**Miscellaneous:**

In Claim 12, the word ratio is misspelled as "ration". Correction is required.

Sequences are present in the application that are not identified by SEQ ID NO: identifiers. The Sequence Rules require that applicants must identify all sequences recited in the instant application by SEQ ID NO: identifiers. Any response that does not fully comply with the Sequence Rules will be considered non-responsive.

Any rejections not repeated are withdrawn.

No Claims are allowed.

Claims 1-3, 5-7, 9, 11-14 are objected to as containing non-elected subject matter. Applicants are required to cancel the non-elected subject matter or take other appropriate action (37 CFR 1.144).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1636

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (703) 308-1906. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D., can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Faxes may be submitted directly to the examiner at (703) 746-5061.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David Guzo  
May 6, 2003

  
DAVID GUZO  
PRIMARY EXAMINER